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Paper No. 10
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Louis R. Bucalo

Serial No. 75/486,134

Amy F. Divino of Steinberg & Raskin for Louis R. Bucalo.

Robert L. Lorenzo, Trademark Examining Attorney, Law Office
111 (Craig Taylor, Managing Attorney).

Before Cissel, Hohein and Chapman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 15, 1998, applicant filed the above-referenced application to register the mark "ALLNEWS" on the Principal Register for "providing of news information that customers access by telephone," in Class 41. The application was based on applicant's assertion that he possessed a bona fide intention to use the mark in commerce in connection with the services.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that the

mark applicant seeks to register is merely descriptive of the services identified in the application because the mark "describes the applicant's news service as one that would be reporting the entire news events or happenings to its telephone clients."

In support of his position, he quoted dictionary definitions of the word "news" as "information about recent events or happenings, especially as reported by newspapers, periodicals, radio or television," and of the word "all" as "being or representing the entire or total number, amount, or quantity: All the windows are open. Deal all the cards." Attached to the refusal to register were copies of six third-party registrations for marks which include the term "ALL NEWS" in which the term is disclaimed or the mark is registered under Section 2(f). The Examining Attorney argued that these registrations establish the descriptiveness of the term sought to be registered.

The Examining Attorney also required amendment to make the recitation of services more definite. He suggested the following language: "telephone information service featuring local, national and international news that customers access by telephone," in Class 42.

Applicant responded by adopting the suggested recitation of services, but arguing that "ALLNEWS" is not

merely descriptive of the services as they are identified in the application, as amended.

The Examining Attorney accepted the amendment to the recitation of services, but was not persuaded by applicant's arguments on the issue of mere descriptiveness. The refusal to register under Section 2(e)(1) was made final with the second Office Action. Submitted with this action in support of the refusal were a number of excerpts from stories retrieved from the Nexis® database of publications. From this evidence it is clear that news is now available to consumers via wireless telephones, and that radio or television stations which provide only newscasts are referred to by the terms "all news stations," "all news radio" or "all news television stations."

Applicant timely filed a Notice of Appeal, followed by an appeal brief. Submitted as exhibits to applicant's brief were copies of third-party registrations of marks which applicant argues are similar to the mark sought to be registered in the case now before us.

In his brief¹, the Examining Attorney objected to the additional evidence submitted with applicant's brief. Trademark Rule 2.142(d) provides that the record in an

application should be complete prior to the filing of the Notice of Appeal. The Board may, in its discretion, permit additional evidence to be submitted after that time, but the rule allows this to be done only in response to a request by either the applicant or the Examining Attorney. In the case at hand, neither made such a request, and the Examining Attorney objected in a timely fashion, so the third-party registrations submitted with applicant's appeal brief have not been considered.

Applicant did not request an oral hearing before the Board.

The sole issue before us in this appeal is whether the term "ALLNEWS" is merely descriptive of a telephone information service featuring local, national, and international news that customers can access by telephone. Based on careful consideration of the record and arguments of applicant and the Examining Attorney, we find that the mark is merely descriptive of this service, and therefore

¹ We accept the Examining Attorney's explanation of the clerical mistake that led to the late mailing of his appeal brief. We therefore have considered it as if it had been timely mailed.

is unregistrable under Section 2(e)(1) of the Lanham Act.

The Examining Attorney and applicant do not disagree on the standard for registrability under Section 2(e)(1). A mark is unregistrable under this section if it immediately and forthwith provides information about a significant quality, characteristic, function, feature, purpose or use of the goods or services with which it is, or is intended to be, used. In re MetPath Inc., 223 USPQ 88 (TTAB 1984), and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). In order to be properly refused registration as merely descriptive, the mark must directly and immediately convey information about the characteristics of the goods or services with some specificity or particularity. If this information is indirect or vague, the mark may be considered suggestive, rather than descriptive, but the mark does not have to describe the services exactly. In re Entenmann's, Inc., 15 USPQ2d 1750 (TTAB 1990).

In the case before us on appeal, the mark applicant seeks to register, "ALLNEWS," is merely descriptive of the services set forth in the amended application because it immediately and forthwith conveys information about a significant characteristic, function or feature of the services, namely that applicant's telephone information

service features all news. Applying the ordinary meanings of the words "all" and "news" to the combination of the two words results in a connotation that is consistent with the other evidence made of record by the Examining Attorney which demonstrates that "all news" and its variants are terms used in the communications industry in connection with broadcast formats featuring only news. Whether prospective customers of applicant's services would interpret the mark as an indication that applicant provides all the news, i.e., everything that is newsworthy, or as an indication that all applicant provides is news, without, for example, music or commentary, as in "all news" radio or "all news" television, is immaterial. Either of these connotations leads to the conclusion that the mark applicant seeks to register is merely descriptive of the services recited in the application.

Applicant makes a number of arguments that are not persuasive of a different conclusion. The first is that when "ALL" and "NEWS" are used together in connection with the recited services, whatever information the resulting mark provides about applicant's services is descriptive only in a "vague" or "indirect" sense. To the contrary, the combination of these descriptive words itself provides specific information with respect to the recited services,

namely that the services consist of providing only news. Applicant submitted no evidence in support of his theory that the mark is descriptive only in a vague or indirect sense.

Applicant contends that a person would have to engage in a multi-stage reasoning process to determine the attributes of applicant's services from consideration of the mark. As the Examining Attorney points out, however, whether a mark is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the mark is used, or will be used, in connection with those goods or services, and the possible significance which the mark would have, because of that context, to the average purchaser of the goods or services in the marketplace where they are sold. In *re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). The test is not whether someone could look at only the mark and correctly speculate as to significant characteristics, purposes or functions of the services with which it is used. The test is whether one who understands what the services are would be provided with information about their characteristics, purposes or functions by consideration of the mark. This test is plainly met in the instant case.

Thus, applicant's argument that because when one encounters the word "news," one does not immediately think of news as reported by telephone is not well taken. The question before us is whether someone who understands that the service is a telephone information service featuring local, national and international news that customers access by telephone would, upon encountering the mark "ALLNEWS" in connection with the service, understand that a significant characteristic or feature of the service is that the only thing applicant's customers can access by telephone is news.

Applicant argues that the term sought to be registered "is being used in a suggestive and non-descriptive manner." (brief, p.4). This application is based on applicant's assertion that he intends to use the mark, not on a claim of actual use of it, however. This record contains no evidence that applicant has in fact used the mark, much less that it has been used in a "suggestive and non-descriptive manner."

Applicant argues that "ALLNEWS" is a coined term, and that the combination of the words "all" and "news" results in a unitary mark which will cause customers of applicant's services to "have to pause and reflect on the significance of the combined designation ALLNEWS in order to understand

that, as used in connection with applicant's services, the telephone can be used to access a service that provides local, national and international news." (brief, p.6). The record before us contains no evidence or reasoning in support of this contention. To the contrary, as noted above, the combination of these two descriptive words results in a term which is itself merely descriptive of the services set forth in the application.

That applicant has combined the words "all" and "news" without a space or hyphen between them does not alter the descriptive significance of the combined term. Combining these two descriptive words into a single term does not result in a mark that is incongruous, unexpected or clever.

Similarly, whether or not anyone else has ever adopted "ALLNEWS" as a mark or used it in connection with the same or similar services is immaterial. In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). Moreover, in view of our ruling with respect to the third-party registrations submitted by applicant with his brief, there is no evidence that others have registered, much less used, marks similar to the one sought to be registered here. Even if the record contained evidence of registration by others of the same or similar marks for the same or similar services, such evidence would not be

determinative of this appeal. The Board is not bound by previous decisions by Examining Attorneys who passed other marks to publication. In re Nett Designs, Inc., 57 USPQ2d 1564 (Fed. Cir. 2001). We are obligated to decide each case before us on its own record and merits. In re Cosvetic Laboratories, Inc., 202 USPQ 842 (TTAB 1979).

The record in this case clearly demonstrates that "ALLNEWS," if used in connection with a telephone information service featuring local, national and international news that customers can access by phone, would be merely descriptive of the services because it would immediately and forthwith inform potential customers of a significant purpose, function, feature or characteristic of the services.

Decision: The refusal to register under Section 2(e)(1) of the Lanham Act is affirmed.

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